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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,121	11/30/2001	Richard R. Lunak	DB000970-000	4436
24122	7590	05/18/2004		
THORP REED & ARMSTRONG, LLP ONE OXFORD CENTRE 301 GRANT STREET, 14TH FLOOR PITTSBURGH, PA 15219-1425			EXAMINER SHAPIRO, JEFFERY A	
			ART UNIT 3653	PAPER NUMBER

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,121

Applicant(s)

LUNAK ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-8, 10-12, 14-19, 21, 23-30, 32, 34-44, 46, 48, 52 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Wallace et al (US 6,564,121 B1).

Wallace et al discloses the following.

As described in Claims 1, 15, 26, 37 and 52;

- a. dispensing and administering medications and issuing medical/surgical supplies using a device communicating with a central database (see abstract);

- b. inputting information about a patient to the device for whom at least one medication may be dispensed and administered (see figure 16B, step 4);
- c. dispensing the at least one medication to the patient by inputting information about the at least one medication to the device (see figure 16C, step (7));
- d. saving the at least one medication to the patient selected (see figure 17C, button (1476);
- e. inputting information about a patient to the device for whom at least one medical/surgical supply may be issued (see col. 1, lines 43-47, col. 10, lines 40-43 and col. 11, lines 54-65);
- f. issuing the at least one medical/surgical supply to the patient by inputting information about at least one medical/surgical supply to the device (see figure 16C, step 7);
- g. saving the at least one medical surgical supply to the patient selected (see col. 32, lines 20-38 and col. 33, lines 4-18);
- h. recording the identity of the supply location (see figure 17C, noting that a "storage location", "PSY1" is identified in one of the fields of the "medication summary.");
- i. a touch screen (420) (see figure 7 and col. 14, lines 1-5);
- j. a radio communications unit (see col. 7, lines 41-47);

As described in Claims 2, 16, 27 and 38;

k. the saving step (4) results in the automatic deduction of the at least one medication from an inventory list saved on the central database (see col. 11, lines 64-67 and col. 12, lines 1-12);

As described in Claims 3, 17, 28 and 39;

l. the automatic deduction triggers an automatic reordering of the at least one medication from the central database if the automatic deduction results in the inventory listing for that medication being less than a predetermined level assigned on the database for that medication (see col. 17, lines 54-65, noting that reorders are placed based upon inventory threshold stockout levels);

As described in Claims 4, 18, 29 and 40;

m. the saving step results in the automatic charging of the cost of the at least one medication to an invoice saved on the central database for the patient selected (see col. 11, lines 64-67 and col. 12, lines 1-12);

As described in Claims 5 and 41;

n. the saving step (7) results in the automatic deduction of at least one medical/surgical supply from an inventory list saved on the central database (see figures 18A-D);

As described in Claims 6 and 42;

o. the automatic deduction of claim 5 wherein the automatic deduction triggers an automatic reordering of the at least one medical/surgical supply from the central database if the automatic deduction results in the

inventory listing for that medical/surgical supply being less than a predetermined level assigned on the database for that medical/surgical supply (again, note that inventory threshold stockout levels are used, which automatically trigger reorder when a particular lower level of inventory is reached);

As described in Claims 7 and 43;

p. regarding claim 6, wherein the saving step results in the automatic charging of the cost of the at least one medical/surgical supply to an invoice saved on the central database for the patient selected (see col. 11, lines 64-67 and col. 12, lines 1-12);

As described in Claims 8, 19, 30 and 44;

q. additionally comprising the step of logging the user onto the central database by inputting information into the device (see col. 18, lines 10-12);

As described in Claims 10, 21, 32 and 44;

r. the step of logging the user onto the central database is accomplished by typing a user ID and password on a menu of the device (see col. 18, lines 10-12);

As described in Claims 11 and 24;

s. the step of dispensing the at least one medication to the patient is done by scanning bar codes associated with the at least one medication (see col. 20, lines 20-29);

As described in Claim 12;

- t. the step of dispensing the at least one medication to the patient is done by selecting the at least one medication from a menu on the device (see figure 29);

As described in Claim 14;

- u. the step of issuing the at least one medical/surgical supply to the patient step is done by selecting the at least one medical/surgical supply from a menu on the device (see figure 16C, step 7);

As described in Claims 23, 25, 34-36 and 48;

- v. the step of selecting a patient for whom at least one medical/surgical supply will be issued is done by selecting a patient from a menu of the device (note that it would have been obvious to select a patient from a menu);
- w. the step of issuing the at least one medical/surgical supply is done by selecting the at least one medical/surgical supply from a menu on the device (see figure 29);

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 13, 20, 22, 31, 33, 45, 47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace et al (US 6,564,121 B1). Wallace et al discloses the following.

As described in Claims 9, 20, 31 and 45;

- x. the step of logging the user onto the central database is accomplished by scanning a user barcode assigned to the user (note that this is a functional equivalent of inputting a login ID and that it would have been obvious to one skilled in the art to provide for this alternative format);

As described in Claims 13, 22, 33, 47, and 49-51;

- y. the step of issuing the at least one medical/surgical supply to the patient is done by scanning bar codes associated with the at least one medical/surgical supply (see col. 20, lines 20-29);
- z. the bar code also provides the location of the supply (note that it would have been obvious for one ordinarily skilled in the art to provide the location in the form of a bar code);

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have scanned a user barcode representing either a user ID in order to access the central database of the system, or a barcode to represent the location of a supply. The representation of such ID information is considered a functional equivalent format

to inputting a login ID and would have been obvious to one of ordinary skill in the art to provide such a bar code. Note that the system uses bar codes for a wide variety of information input such as to identify drugs and prescriptions, as mentioned at col. 8, lines 36-38. Also, applicant's specification does not appear to provide any specific reason for presenting such location or ID information in the barcode format over other functionally equivalent formats that present the same information in substantially the same way.

The suggestion/motivation would have been to provide immediate exchange of information at a patient's bedside. See col. 1, lines 43-47.

Therefore, it would have been obvious to use Wallace to obtain the invention as described in Claims 9, 13, 20, 22, 31, 33, 45, 47 and 49-51.

Response to Arguments

5. Applicant's arguments filed 2/6/04 have been fully considered but they are not persuasive. Applicant asserts in regards to Wallace's system that "all dispensing occurs at one location, the location where the dispensing device is located" and that there is no "portable device" used.

A medication/drug item is considered to be a functional equivalent to a supply item. The system of either the Applicant or Wallace works the same regardless of the type of item issued. Issuing a medication or supply is construed as the validation and intake of the prescription information, the patient identifier, and verification with other administrative or cost interfaces such as health insurance funds, etc. Wallace's system

discloses performing an issuing function, which is performed on a central computer (46). The central computer can be remote from several dispensers, and connected by a communications connection such as the internet. See figures 4A or 4C, for example. See also figure 14a, in which a wireless signal is sent to dispenser 324.

Wallace mentions the use of a portable terminal, notebook computer or hand-held PDA at col. 9, lines 37-38. Further, one of the motivating factors behind Wallace's system is "to maximize system flexibility and ease of use for the doctor and staff without compromising safety. Finally, the dispenser system is designed as either a freestanding dispenser, as part of a local area network in a physician's office, or as a "centralized network in conjunction with **product release at a remote location.**" See col. 9, lines 42-48.

Applicant has apparently attempted to broaden the claims with the current amendment where narrowing is required. Therefore, the rejection of Claims 1-52 over Wallace is maintained.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

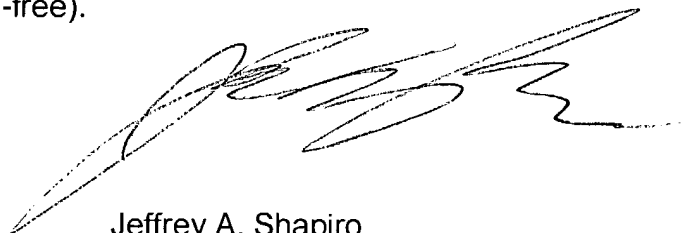
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro
Examiner
Art Unit 3653

May 16, 2004



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